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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,758	12/13/2001	Kunihiro Shima	108384-00036	3728
6449	7590	04/21/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			ZIMMERMAN, JOHN J	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/926,758	<b>Applicant(s)</b> SHIMA, KUNIHIRO	
	<b>Examiner</b> John J. Zimmerman	<b>Art Unit</b> 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 and 5-10 is/are pending in the application.  
4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## SECOND OFFICE ACTION

### *Amendments*

1. This Office Action is in response to the correspondence titled "Amendment" received January 12, 2004. Claims 3 and 5-10 are pending in this application.

### *Election/Restrictions*

2. Newly submitted claim 10 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claim is an article claim wherein the previously pending invention was to a method of producing Cu-Ag alloy plate. Only a search for the claimed method and not a search for the article has been performed in this application. For the purposes of restriction, inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as establishing the optimum annealing temperature for strength and conductivity by trial and error, without establishing a strength-temperature curve and a conductivity-temperature curve from data. While it is noted that claim 10 is a product-by-process claim and incorporates the same process steps as described in process claim 5, a product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner

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can demonstrate that the product as claimed can be made by another materially different process such as the alternative process described above. See *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324, for analysis of weight given to process step recitations in product claims.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

4. The disclosure is objected to because of the following informalities: The disclosure refers to claim 4 (see page 10, line 14). No such claim is currently pending in this application. It is suggested that applicant delete any reference to specific claim numbers because the numbering and content of the claims in an application may change during prosecution and publication.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 3 and 5-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

7. The original disclosure used the term "composed" to describe the Cu-Ag alloy composition (e.g. see line 3 of original claim 3). Applicant has now amended the claims to recite "comprising" to describe the Cu-Ag alloy composition (e.g. see amended claim 3, line 3; new claim 6, line 4). The broadening of the composition to "comprising" is not supported by the original disclosure. The transitional phrase "composed of" (originally used in the applicant's disclosure) has been interpreted in the courts as either "consisting of" or "consisting essentially of", depending on the facts of the particular case. See *AFG Industries, Inc. v. Cardinal IG Company*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001) (based on specification and other evidence, "composed of" interpreted in same manner as "consisting essentially of"); *In re Bertsch*, 132 F.2d 1014, 1019-20, 56 USPQ 379, 384 (CCPA 1942) ("Composed of" interpreted in same manner as "consisting of"; however, court further remarked that the words "composed of" may under certain circumstances be given, in patent law, a broader meaning than "consisting of."). See MPEP 2111.03. In view of applicant's use of the phrase "accounting for the balance" when describing the alloy and also the description of the alloy and the data in the original disclosure directed only to a two component alloy of Cu-Ag, the examiner finds evidence that the term "composed" should be interpreted as "consisting" in this instance.

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Applicant's amendment to "comprising" is therefore new matter. Changing the term "comprising" (claim 3, line 3; claim 6, line 4) back to "composed of" or to "consisting of" will overcome the rejection on this matter.

8. Furthermore, it is not clear where applicant obtained support for the limitation "workability of 40-76%" in claim 5, lines 2-3). Barring evidence of support, this limitation is considered new matter. Claims 5, 7 and 9 are affected by this issue.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 3 and 5-10 have been considered and are persuasive in removing the prior rejections. A patentable distinction in results attributed to the annealing temperature range in step "(e)" of independent claim 3 is supported by Figure 3, and is not made obvious by the art of record. The "method of determining" in independent claim 6 incorporates steps (e.g. "(g)", "(h)") is not made obvious by the art of record. This application would be allowable upon the resolution of the rejection of the claims under 35 U.S.C. 112, first paragraph, and the cancellation of the non-elected claim.

#### ***Conclusion***

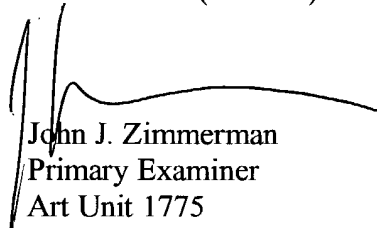
10. Applicant's amendments adding new matter necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE**

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MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
April 14, 2004